

Docket No.: FQ5-616



KAT.045

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shigeru Kurosawa

Serial No.: 10/686,526

Group Art Unit: 2624

Filed: October 16, 2003

Examiner: Dennis Rosario

For: PORTABLE COMUNICATION APPARATUS HAVING A CHARACTER
RECOGNITION FUNCTION

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

RESPONSE TO ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER.

Sir:

In response to the Office Communication dated March 24, 2009 (copy enclosed), enclosed are corrected pages 2, 9 and 16 to indicate a correction of the grounds of rejection of the appealed claims.

Respectfully submitted,

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Date: 3-27-09

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III. STATUS OF CLAIMS

Claims 1-5, 10, 12-15, 18, and 20 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by US Patent No. 5,912,705 to Saruwatari. Claims 6-8 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Saruwatari, further in view of US Patent No. 6,639,626 to Kubo et al. Claims 9, 11, 16, and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Saruwatari, further in view of US Patent Publication No. 2002/0058536 to Horii et al.

All of the above rejections are being appealed.

IV. STATUS OF AMENDMENTS

A Request for Reconsideration Under 37 CFR §1.116 was filed on June 3, 2008. In the Advisory Action dated June 23, 2008, the Examiner indicated that the arguments in the Request for Reconsideration were not persuasive and that the rejections of record were maintained.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The basis in the specification for the claims is as follows:

1. (Rejected) A portable communication apparatus (10, Fig. 1A) comprising:
 - an image-capturing section (17, Fig. 2) for capturing an image depending on an operation of a shutter key and for sensing images in real-time (lines 3-8 of page 9);
 - a display (15, Fig. 4) that includes a viewfinder display that displays said real-time sensed images and that includes a reference frame (31, Fig. 4) that indicates a predetermined optimal size of characters to achieve a predetermined success rate for character recognition for a character positioned within the reference frame (Figs. 5A&5B; lines 7-11 of page 3; lines 21-24 of page 11); and
 - a character recognition section (205 of Fig. 2) for recognizing a character from a captured image (S180 of Fig. 6A; S530 of Fig. 7; S730 of Fig. 9; line 10 of page 10).

Appellant's Brief on Appeal
S/N: 10/686,526

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant presents the following issues for review by the Board of Patent Appeals and Interferences:

GROUND #1: THE ANTICIPATION REJECTION FOR CLAIMS 1-5, 10, 12-15, 18, AND 20, AS BASED ON SARUWATARI;

GROUND #2: THE OBVIOUSNESS REJECTION FOR CLAIMS 6-8 AND 17, AS BASED ON SARUWATARI, AS MODIFIED BY KUBO; AND

GROUND #3: THE OBVIOUSNESS REJECTION FOR CLAIMS 9, 11, 16, AND 19, AS BASED ON SARUWATARI, AS MODIFIED BY HORII.

GROUND #3: THE OBVIOUSNESS REJECTION FOR CLAIMS 9, 11, 16, AND
19, AS BASED ON SARUWATARI, AS MODIFIED BY HORII

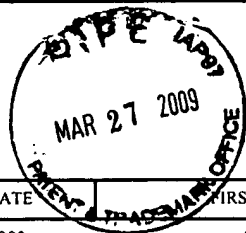
The Examiner maintains the rejection based upon secondary reference Horii, because, as best understood, of the description in paragraph [0099] of Horii: “... *it is possible to easily use the calling function, the Internet connection, mail transmission, and other functions.*”

However, Appellant respectfully submits that Horii is non-analogous to primary reference Saruwatari. Saruwatari involves a camera, whereas Horii involves a mobile phone. Appellant submits that the Examiner's initial burden to establish a *prima facie* rejection is to provide a rationale to modify the primary reference. There would be no reason to modify the camera described in primary reference Saruwatari, since it is not a communication device, so there would be no need to modify this camera for the reason described in paragraph [0099] of the secondary reference as a substitution or improvement known in the art for cameras.

Moreover, Appellant submits that the Examiner's rationale is merely a circular argument wherein the reason for modification is simply because one would thereby have achieved the alleged benefit of having made the modification. Appellant submits that such circular reasoning clearly constitutes improper hindsight.



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EXAMINER

ROSARIO, DENNIS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Shigeru Kurosawa

Application No. 10/686,526
Technology Center

Mailed: March 24, 2009

Before Deborah Perry, *Supervisory Paralegal Specialist, Review Team*
Perry, *Supervisory Paralegal Specialist, Review Team*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on February 19, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter requiring attention prior to docketing.

APPEAL BRIEF, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief filed September 2, 2008 under the heading "Grounds of rejection to be reviewed on appeal" is not consistent with the grounds of rejection of claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified.

A review of the last Office action, finds that

"Claims 9,11,16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saruwatari (U.S. Patent 5,912,705) in view of Horii et al. (U.S. Patent Application Publication No.: (U.S. 2002/0058536 A1)."

Whereas Appellant(s) have improperly listed these claims as
STATUS OF CLAIMS

"...Claims 9,11,18 and 19 are rejected under 35 U.S.C. 103(a) as..."

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

"...GROUND #3: THE OBVIOUSNESS REJECTION FOR CLAIMS 9, 11, 18, AND 19..."

Correction of the Grounds of rejection to be reviewed on appeal for all claims is required. Please inform the Applicant that it is not required to resubmit the Appeal Brief in its entirety. It is acceptable to provide, exclusively, the corrected sections and adequate cover/transmittal.

CONCLUSION

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on September 2, 2008 defective;
- 2) notify the Appellant to file a paper properly addressing the Grounds of rejection of all claims; and
- 3) for any such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DP/mev

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